

REMARKS

Claims 5-16 are all the claims pending in the application; claims 5, 15 and 16 are allowed; claims 6-14 are rejected.

Upon entry of this Amendment, claim 6 will be cancelled, and claims 5 and 7-16 will be pending.

Support for the amendment to claim 7, to recite the steps of the method used to determine the effects of the test substance on DP receptor activity, may be found in Example 3 (pages 20-22) of the specification.

Support for the amendment to claims 8 and 9 may be found, for example, at page 6, lines 8-13, and page 16, lines 25-27, where different effects on the function of the receptors are discussed.

Support for the amendment of the specification is discussed below in section I.

No new matter has been added. Entry of this amendment is respectfully requested.

I. New Matter Rejection

At paragraph 3 of the Office Action, the Examiner objects to the amendment of “13,14-dehydro-15-keto PGD2” to “13,14-dihydro-15-keto PGD2” as being new matter.

Applicants respectfully assert that the replacement of the term “dehydro” with the term “dihydro” is simply the correction of an obvious misspelling.

As evidence of the misspelling, Applicants note that the legend of Figure 3 of the application uses the correct term, i.e., “dihydro”. In the corresponding section of the specification discussing this figure (page 23, lines 12 and 18), the term “dehydro” is mistakenly used instead. This contradiction makes it clear that an error has been made.

Furthermore, Applicants submit that the skilled artisan would understand that the term “dihydro” is the correct term in this context and that the term “dehydro” is an obvious misspelling.

Applicants therefore respectfully request entry of the amendment to Figure 4 and page 24 of the specification, as set forth in the Amendment filed April 13, 2004, and the amendment to page 23, as set forth in the instant Amendment, to correct this obvious error.

II. Claim Objections

At paragraph 4 of the Office Action, claim 7 is objected to under 37 C.F.R. §1.75(c) as being a substantial duplicate of claim 6.

Included herewith is an amendment to the claims, canceling claim 6. In view of the cancellation of claim 6, the issue of possible duplicate claims becomes moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

III. Claim Rejections Under 35 U.S.C. §112, first paragraph

At paragraph 5 of the Office Action, claim 11 (and claims 12-14 dependent therefrom) is rejected under 35 U.S.C. §112, first paragraph, as lacking adequate written description support in the specification as filed.

The Examiner states that there is no support in the specification for recitation of human CRTH2 being present “on a cell.” The Examiner states that a cell expressing human CRTH2 could express the receptor internally instead.

Applicants respectfully note that at page 14 of the specification, lines 13-19, there is a discussion of using a type of host cell for expression of human CRTH2 which enables addition of a sugar chain to human CRTH2. Included within this discussion is mention of the “extracellular

site of human CRTH2,” which exists as “a human membrane protein.” This discussion provides clear written description support for recitation of human CRTH2 being present “on a cell.”

Furthermore, Example 6 (pages 23-24) of the application discusses an experiment that uses immunofluorescence and flow cytometry to determine whether there is down modulation of human CRTH2 expressed by cells treated with a test substance. The skilled artisan would understand, given the experimental conditions included in the Example, that flow cytometry determines the fluorescence intensity on the surface of a cell.

Thus, Applicants respectfully assert that there is clear and ample written description support for the recitation of human CRTH2 being expressed “on a cell” as recited in claim 11. Accordingly, Applicants request reconsideration and withdrawal of this rejection.

IV. Claim Rejections Under 35 U.S.C. §112, second paragraph

A. At paragraph 8B of the Office Action, claims 6, 8 and 9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner states that claim 6 is indefinite in its recitation of “selectively modulates human CRTH2 activity” because it is not clear to what this activity is being compared. The Examiner includes claims 8 and 9 in the rejection because they depend from claim 6.

Included herewith is an amendment to the claims, canceling claim 6. Claims 8 and 9 have been amended to depend from allowed claim 5. In view of the cancellation of claim 6, the issue of the alleged indefiniteness of claim 6 becomes moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

B. At paragraph 8C of the Office Action, claims 6-9 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner states that the claims appear to recite substances for which the activity is already known. The Examiner proposes alternative wording for the claims to make clear that the activity of the test substances is not known prior to being tested.

Included herewith is an amendment to the claims, canceling claim 6 and thus making the rejection of this claim moot. Claims 8 and 9 have been amended to depend from allowed claim 5, and to make clear that the method recited in claim 5 screens for inhibitors (claim 8) or activators (claim 9) of human CRTH2 activity (Applicants thank the Examiner for the helpful suggestion). Claim 7 has also been amended to include an additional step in the recited method, namely screening the test substance for activity on the DP receptor.

In view of the amendments to the claims, Applicants respectfully assert that the claims are definite and therefore request reconsideration and withdrawal of this rejection.

C. At paragraph 8D of the Office Action, claim 10 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner states that claim 10 is indefinite because it is unclear whether the binding of the test substances is performed as part of the claimed method, or if the substance is identified “after the fact” as one which has bound to the CRTH2 receptor.

Applicants include herewith an amendment to claim 10, making it clear that the change in the activity of human CRTH2 that is being detected in the method recited in claim 5 is due to the binding of the test substance to human CRTH2. Thus, it is clear that the binding of the test substance is performed as part of the claimed method.

In view of the amendment, Applicants respectfully assert that the claim is definite and therefore request reconsideration and withdrawal of this rejection.

D. At paragraph 8E of the Office Action, claim 12 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner states that claim 12 is indefinite due to the use of the phrase “CRTH2 molecules.”

Applicants include herewith an amendment to claim 12, canceling the term “molecules” and thus making it clear that it is the down modulation of the receptor itself that is being recited.

In view of the amendment, Applicants respectfully assert that the claim is definite, and therefore request reconsideration and withdrawal of this rejection.

E. At paragraph 8F of the Office Action, claim 12 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite.

The Examiner finds the phrase “enhancement of migration” to be indefinite.

Included herewith is an amendment to the claims, canceling recitation of “enhancement of migration” from claim 12. In view of the amendment of claim 12, the issue of the alleged indefiniteness of claim 12 becomes moot. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

V. Claim Rejections Under 35 U.S.C. §103

At paragraph 9 of the Office Action, claims 11-14 are rejected under 35 U.S.C. §103, as being unpatentable over Li et al.

The Examiner states that as claim 11 (and dependent claims 12-14) recites new matter (CRTH2 present “on a cell”), the claim is not supported by any of the prior art documents, and thus is obvious in view of the teachings of Li et al.

In response, Applicants refer to the comments regarding claim 11, and the recitation of “on a cell”, above in section **III**. As explained therein, the specification provides clear support for the phrase “on a cell.”

Moreover, similar support for the phrase “on a cell” may be found in Japanese application number 11-236207 at page 15, lines 19-25, and in Japanese application number 2000-153172 at page 15, lines 18-24.

As the claim does not recite new matter, and because the claim is adequately supported by the priority applications, Applicants respectfully assert that Li et al. does not teach or make obvious any aspect of this claim. Applicants therefore respectfully request reconsideration and withdrawal of this rejection.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.116
U.S. Appln. No. 10/069,148

Q68584

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: October 27, 2004